REMARKS

Claims 1-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sigona et al. (U.S. 5,694,150), White et al. (U.S. 5,982,351), and the Mastering Windows 3.1 reference. Applicant respectfully traverses this rejection for the reasons of record and as follows. The Examiner has not established a *prima facie* case of obviousness against the present invention, nor has the Examiner fully answered all of the material traversed by Applicant in the previous three Responses.

Applicant again maintains and incorporates by reference herein those arguments previously advanced on pages 10 through 12 of Amendment C, filed April 30, 2003. Applicant respectfully requests that the Examiner reconsider those arguments and withdraw this Section 103 rejection. Additionally, Applicant respectfully requests that the Examiner consider the following new arguments, and expansions upon the previous arguments.

Section 2143.03 of the MPEP requires of the Examiner, to establish a *prima facie* case of obviousness against a claimed invention, that all claimed features and limitations of the invention are either taught or suggested by the prior art. In the present case, however, the Examiner has not met this requirement. None of the three cited prior art references, whether taken alone or in combination, disclose or suggest all of the features of the present invention.

No combination of the three references teaches or suggests how, from a plurality of menus, a selected menu can be displayed at the same location as a cursor, on

the basis of either the number of consecutive actuations of the same input device in a given time interval, or the duration of time that same input device is actuated. It is not merely some individual elements of the claimed invention that the Examiner must show in the prior art, but also the claimed relationships between these several elements which must also be shown. Section 2143.03 further requires that the Examiner consider all of the words in the claims in judging the patentability of those claims against the prior art. In repeating his previous rejection, however, the Examiner has ignored significant claim language and features of the present invention.

As previously discussed, Sigona merely teaches a system including a display, where multiple users activate different input devices at different locations. Sigona's system is structured so that simultaneous activations of the different input devices from the different users do not come into conflict. Nowhere does Sigona teach or suggest actually counting the number of actuations of the same input device within a predetermined interval, counting the duration of time a single input device is activated, or even menus at all. The Examiner has not answered any of the many meritorious arguments specifically traversing the Examiner's assertions that Sigona teaches or suggests such features.

For example, the Examiner continues to assert on page 2 of Paper No. 14 that Sigona teaches to ascertain the number of consecutive actuations of an input device in a give time interval, as well as the duration of time of the input events. Sigona, on the other hand, teaches no such things, and the Examiner has not responded to any of

Applicant's many meritorious arguments explaining exactly why the Examiner's interpretation of Sigona is erroneous. Neither of Sigona's counters, which are cited by the Examiner, actually count the number of input events within a given time interval, or the duration of time of an input event. Applicant respectfully requests that the Examiner respond to these, and to the previous, arguments traversing this interpretation, or withdraw the rejection. Similarly, Applicant also respectfully requests that the Examiner cite to exactly where in the Sigona reference menus are "implicitly" taught. (Examiner's remarks on page 2 of Paper No. 14). Applicant submits that Sigona neither explicitly nor implicitly teaches any menuing functions associated with its system.

Unlike Sigona, White does teach some menuing features. White, however, nowhere teaches menus displayed at the same location as the cursor, or that the menu displayed is a selected menu from a plurality of menus, which is displayed at the same location as the cursor as a result of the number of consecutive actuations of the input device within the time period, or the duration of the actuation of the device. White only teaches that different menus may be obtained, but nowhere does White teach that these menus appear at the same cursor location. Furthermore, White clearly describes that the same menus will always appear irrespective of the number of times an input device is actuated within a given time period, or the duration that input device is actuated. White even emphasizes this consistency of the menu displays as an advantageous feature of its disclosure in guiding the user through the operation of its communications device.

The Mastering Windows reference does teach a cursor display, and that a menu may appear at one particular location. However, the Mastering Windows reference nowhere teaches that a different menu may be selected from a plurality of menus at any single cursor location. Furthermore, the Examiner's assertion that the Mastering Windows reference teaches that different menus may be accessed when the same cursor is held for a predetermined time is wholly unsupported by the reference. No such teaching appears in the portion of the reference cited by the Examiner. The Mastering Windows reference could be broadly read to describe that menus can appear for a "double-click" of the same input device, however, the Examiner ignores important claim language of the present invention when asserting that this feature reads upon the present invention. The present invention actually features that the different menus are available at the same location of the cursor on the display screen. The reference, on the other hand, teaches no such features.

In fact, the reference clearly shows that the cursor must move to different locations to access different menus. (See pages 21, 23). The reference even expressly teaches that the different menus are only accessed by moving the cursor to the name of the specific menu in question, which menu names are clearly shown to appear at different locations on the display screen. (See page 22, line 1). Not only does the reference teach that different menus are only accessible at different locations, the reference even teaches that those particular menus are accessed with only a single actuation of the input device. (See page 868). The reference only once describes a "multiple actuation" of an input

device – a double-click of the mouse button (page 30, lines 1-2) – but only in respect to selecting a directory, and not a menu.

The reference clearly distinguishes in this respect between menus, on one hand, and directories, folders, and windows, on the other hand. Menus are accessed with a single-click at the cursor location, and folders, directories, and/or windows, may be accessed with a double-click, but then do not appear at the same location as the cursor. With respect to menus specifically, nothing in the Mastering Windows reference teaches or suggests anything about menus being determined on the basis of multiple actuations of the same input device for the same location of the cursor, or the duration of time that the input device is actuated.

In fact, none of the references teach or suggest to consider the actual number of times a single input device is actuated within a predetermined time period, or to consider the duration of time a single input device is actuated. The Examiner even admits on page 3 of Paper No. 14 that neither Sigona nor White teaches actuations of the same input device. As described above, the Mastering Windows reference also fails to teach multiple actuations with respect to menuing functions.

Equally as important to the consideration of the patentability of the present invention is the fact that none of the references alone or in combination teach or suggest anything about the relationship between the selected menu displayed, and the number of times, or the duration, the input device is actuated. This relationship between the features is a specifically recited feature of the claims of the present invention, and the Examiner

has never cited to anywhere in the prior art where such a feature is shown. Because the Examiner has failed to establish where these specific features of the present invention may be found, a *prima facie* case of obviousness has not been established, and the Section 103 rejection must be withdrawn for at least these reasons.

Not only has the Examiner failed to show all of the features and limitations of the present invention, the Examiner has also demonstrated an impermissible use of hindsight in combining the three cited references in an obviousness rejection against the present invention. Impemissible hindsight occurs when there is no motivation or suggestion within the prior art references themselves to combine the references, without the benefit of the present Application. In the present case, no such motivation is taught or suggested by any of the prior art references.

In fact, the Examiner specifically demonstrates impermissible hindsight on page 3 of Paper No. 14 when recognizing that neither Sigona nor White teaches that the same input device is actuated, but then asserting that such a feature as appearing in the present claims "could be possible" in the Sigona reference. The Examiner here expressly recognizes that the feature of the present invention in question does not appear in the cited references, and clearly demonstrates that he obtains the knowledge of this feature of the present invention only from the present Application itself ("could be possible"). Whether or not a patentably distinct feature of the present invention "could be possible" with a prior art reference is not a test for obviousness, or patentability. In establishing his rejection, the Examiner is instead required to show that all such features of the present are

specifically taught or suggested by the prior art. Because the Examiner here admits that the prior art is lacking, the Section 103 rejection must be withdrawn for at least these reasons as well.

Moreover, even if the Examiner were somehow able to find all of the features and limitations of the present invention in a combination of prior art references, the Examiner also has the additional burden to show a teaching or suggestion within the references themselves for the motivation to combine those specific references. See In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). In the present case, the Examiner has not done so. The Examiner only refers to a motivation purported to be in the White reference, namely, to "use the burden of input management and to make input operations (such as a single stroke) acted upon more efficiently." White, however, does not express such any motivation.

In fact, White actually describes that its predictive menuing mode is instead to "help the user to operate the portable subscriber unit by guiding the user through a sequence of menu selection steps in the correct order." (Col. 5, lines 34-37). The Examiner has provided no rationale for how this teaching from White is applicable to the present invention, which does not guide the user through predictive menus, or require a "correct order." The Examiner has further failed to provide any rationale for how this teaching from White provides any motivation to combine White with Sigona. As previously discussed, Sigona teaches nothing about menus specifically, nor how the actuation of an input device can relate to any menu display.

The Examiner repeats this same motivation, as purported from the White reference, in reference to Mastering Windows. The Examiner asserts that this motivation provides the rationale to combine the Mastering Windows reference with the other two references, because the Examiner asserts that the Mastering Windows reference teaches that different menus may be accessed "when a same cursor is held for a predetermined time." The Mastering Windows reference, however, teaches no such feature, and the Examiner provides no support for such an assertion. Accordingly, both the Examiner's interpretation of the prior art references, as well as his motivation to combine the references, are erroneous. For these further reasons, the Section 103 rejection should again be withdrawn.

Lastly, the Section 103 rejection should be withdrawn because the Examiner has not answered the majority of material traversed by Applicant in the previous three Responses, nor has the Examiner disputed any of the advantages of the present invention which are realized over all of the prior art references, alone or in combination. Section 707.07(f) of the MPEP places a burden upon the Examiner, when repeating a previous rejection, to first answer the substance of all of Applicant's arguments traversing that rejection. In the present case, the Examiner simply has not done so.

Specifically, Applicant has pointed the Examiner's attention to several portions of the three cited references which actually teach away from the present invention itself. One such teaching in particular from Sigona, for example, teaches to

reset the system counter each time a new actuation of an input device is detected. In other words, Sigona teaches away from actually using any count between input actuations in reference to its display. Also, as discussed above, the Mastering Windows reference specifically teaches away from accessing different menus at the same cursor location. The reference instead expressly describes to move the cursor to a different location (the different menu names) only to access different menus. The Examiner should be required to respond to these, as well as all of the previous, arguments traversing the outstanding rejection, or withdraw the rejection.

The Examiner should be required to establish how any of the prior art references, alone or in combination, could realize the advantages of the present invention, or also withdraw the rejection. To date, the advantages of the present invention of record remain undisputed by the Examiner. Namely, the Examiner has not even asserted how the cited prior art could possibly allow different menu selection to appear on a display, according to how often or long such menu options are accessed. According to the specifically recited claim features of the present invention, the user may advantageously, given repeated actuations of specific menu features, realize a displayed menu more particularly attuned to those menu features that the user most often accesses. None of the three cited references, alone or in combination can achieve such results.

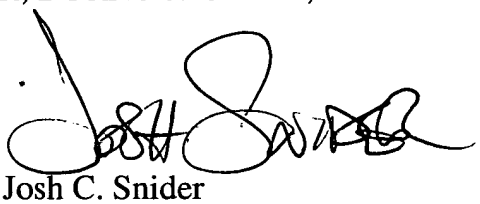
Sigona teaches nothing about different menu options. White and the Mastering Windows reference both teach that the same menu options will always be displayed, irrespective of how often those menus are accessed. Because these advantages

of the present invention remain wholly undisputed by the Examiner, a case of obviousness against the present invention, even if one could have been properly established, has been sufficiently rebutted by Applicant. For even these further reasons, the Section 103 rejection is once respectfully traversed, and should be withdrawn.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-12, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By 

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